

### **REMARKS/ARGUMENTS**

Claims 1-30 are pending in the application. Claims 1-7, 14-18, 24-26, 29, and 30 stand rejected. Claims 8-13, 19-23, 27, and 28 stand objected to as dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the Examiner's early indication of allowable subject matter.

Claims 1 and 7 have been cancelled without prejudice. Claim 23 has been numbered to correct the inadvertent omission of the claim number. Claim 24 has been amended to correct a typographical error.

Claim 31 has been added and combines selected limitations of claims 1 and 7. Claims 2, 6, 8, and 14 have been amended to change their dependency to claim 31. Claims 3-5, 9-13, 15-22, and 25-30 remain unamended.

No new matter has been added by the foregoing amendments, full support therefore being shown in the drawings and specification as filed. All claims remaining in the application are believed to now be in condition for allowance.

Reconsideration and reexamination of the application is respectfully requested in view of the referenced amendments and the following remarks.

#### **Claim Rejections - 35 U.S.C. §102(b)**

Claims 1-5, and 14 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 4,558,640 to Marchant. The rejection is traversed.

The claimed invention is not anticipated under §102 unless each and every element of the claimed invention is found in the prior art. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367; 231 USPQ 81 (Fed. Cir. 1986). To anticipate, a single reference must teach each and every limitation of the claimed invention. *Eolas Technologies Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1335; 73 U.S.P.Q.2D (BNA) 1782 (Fed. Cir. 2005). The identical invention must be

shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226; 9 USPQ2d 1913 (Fed. Cir. 1989).

Claim 1 has been cancelled without prejudice. Thus, the rejection of claim 1 is moot. Claims 2-5 and 14 have been amended to depend from new claim 31. The patentability of new claim 31 will be briefly addressed.

Claim 31 in pertinent part calls for a coffeemaker having a housing with an open top, a front portion, and a rear portion. The coffeemaker also has a front cover for covering only the front portion of the housing. The front cover is pivotally mounted to the housing for movement between a closed position, where the front cover overlies a filter basket and an inlet, and an open position, where the front cover is away from the filter basket and the inlet to permit the insertion and removal of a filter into and from the filter basket through the open top and the introduction of water through the open top into the inlet and into a reservoir in the rear portion through the conduit.

Marchant '640 discloses a coffeemaker having a front portion supporting a filter basket, and an inlet extending from the front portion to a reservoir in a rear portion. Marchant '640 also discloses the existence of a lid, but does not illustrate the lid or described in any detail. Marchant '640 merely states "When in use the combined reservoir holder 6 is covered by a lid (not shown) which fits over the side and end walls 15, 20 and 21." *Col. 3, ln. 27-29*.

Marchant '640 does not disclose a pivotally mounted cover, and does not disclose a cover extending over only a front portion of the coffeemaker housing. Indeed, Marchant '640 indicates that the cover is a single piece that extends over the entire housing. Thus, each and every element of the invention of claim 31 is not found in Marchant '640, and Marchant '640 does not disclose the identical invention of claim 1 "in as complete detail as is contained in the claim."

For the above reasons, claim 31 is not anticipated by Marchant '640. For the same reasons, claims 2-5 and 14, which depend from claim 31, are not anticipated by Marchant

‘640. Applicant requests the withdrawal of the rejection of claims 1-5 and 14, and the allowance of claims 2-5, 14, and 31.

Claims 24-26, 29, and 30 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 3,877,600 to Beil. The rejection is traversed.

Beil ‘600 discloses a cigar/cigarette ash receptacle 12 with a two-piece cover 10 comprising identical semicircular cover portions 30 that serve as an ashtray when in a closed position. An inclined actuating member 54 is attached to a peripheral portion 48 of a first cover portion 30. Depressing the actuating member 54 pivots the first cover portion 30 to an open position and brings the actuating member 54 into contact with the second cover portion 30 to move the second cover portion 30 into an open position. Movement of the second cover portion 30 into an open position, however, will not move the first cover portion 30 into an open position.

Claim 24 calls for a coffeemaker having a housing with an open top, a front portion, and a rear portion. The coffeemaker also has a front cover for covering the front portion of the housing, and a rear cover for covering the rear portion of the housing. A linkage connects the covers to move the rear cover with movement of the front cover.

A linkage is defined as “A system of interconnected machine elements, such as rods, springs, and pivots, used to transmit power or motion.” *American Heritage® Dictionary of the English Language, 4th Ed., Houghton Mifflin Company (2000)*. The linkage is described in the specification consistent with this definition. For example, the linkage arm 140 is an elongated member having a pivot bearing 152 at one end and a translating portion 142 at the other end. The pivot bearing 152 is pivotally attached to the rear cover, and the translating portion 142 is pivotally and slidably attached to the front cover. Thus, the linkage arm 140 is analogous to a rod having pivots.

The linkage called for in claim 24 is missing in Beil ‘600. The actuating member 54 in Beil ‘600 is not a linkage. It is not pivotally attached to either cover portion 30. It is not a rod or a spring. It is a lever fixedly attached to one cover, and unattached to the other.

Furthermore, claim 24 calls for a coffeemaker. Beil '600 relates to an ash receptacle. Beil '600 does not show "the identical invention ... in as complete detail as is contained in the claim." *Richardson, supra*. The Examiner's attempt to support his reliance on Beil '600 by arguing that the Beil '600 device "could be used to produce a beverage" is unavailing. Not only has the Examiner failed to explain how an ash receptacle could be used to brew coffee, the ash receptacle objectively cannot be used for such purpose without modifications of such breadth as to render the resulting device entirely unrecognizable from the Beil '600 ash receptacle.

For the above reasons, claim 24 is patentable over Beil '600. Because claims 25, 26, 29, and 30 depend from claim 24, they are for the same reasons patentable over Beil '600. Applicant requests the withdrawal of the rejection, and the allowance of claims 24-26, 29, and 30.

#### **Claim Rejections - 35 U.S.C. §103(a)**

Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Marchant '640 in view of U.S. Patent No. 5,687,636 to Diore et al. The rejection is traversed.

Claim 7 has been cancelled without prejudice. Thus, the rejection of claim 7 is moot.

Diore '636 discloses a coffeemaker having a water reservoir in a front portion, closeable by a first hinged cover, a basket for coffee grounds in a rear portion, closeable by a second hinged cover, and a server positioned below the reservoir, and below and to the side of the basket. The covers are not interconnected.

The standards for a finding of obviousness must be strictly adhered to. Simply citing one or more prior art references that illustrate different facets of the invention and then concluding that it would be obvious to combine the references to create the applicant's invention is wholly inadequate.

A claimed invention is unpatentable if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art....The ultimate determination of whether an invention would have been obvious under 35 U.S.C. §103(a) is **a legal conclusion based on underlying findings of fact.**<sup>1</sup>

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field....Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

Most if not all inventions arise from a combination of old elements....Thus, every element of a claimed invention may often be found in the prior art....However, **identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention**....Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, **there must be some motivation, suggestion or teaching of the desirability of making the specific combination** that was made by the applicant....Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved....In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references....The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art....Whether the Patent Office Examiner relies on an express or an implicit showing, **the Examiner must provide particular findings related thereto....Broad conclusory statements standing alone are not "evidence."**

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<sup>1</sup> The underlying factual inquiries include (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; and (3) the differences between the claimed invention and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966).

*In Re Werner Kotzab*, 217 F.3d 1365; 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 2000)(citations omitted)(emphasis added).

The combination as made in the Office action fails to identify any motivation, suggestion, or teaching in either Marchant '640 or Diore '636 of the desirability of combining Marchant '640 and Diore '636 to arrive at Applicant's invention. There has been no statement identified in either Marchant '640 or Diore '636 as to the desirability of the asserted combination, there has been no discussion of the knowledge of one of ordinary skill in the art or the nature of the problem to be solved, there has been no identification of what the teaching of Marchant '640 and Diore '636, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to one of ordinary skill in the art as required for a showing of motivation. The combination as asserted fails to provide any particular findings related to any motivation, suggestion, or teaching of the desirability of combining Marchant '640 and Diore '636. The combination as asserted simply relies upon "broad conclusory statements standing alone," which can only lead to the conclusion that the combination as asserted is simply based on impermissible hindsight reconstruction of Applicant's invention.

Claim 6 now depends from claim 31. As discussed above, claim 31 is patentable over Marchant '640. Claim 31 is also patentable over Marchant '640 in view of Diore '636, since Diore '636 fails to provide elements of claim 31 not disclosed in Marchant '640. Claim 31 calls for a coffeemaker having a water reservoir located in the rear portion of the housing, and a filter basket located in the front portion of the housing. The coffeemaker also has a front cover pivotally mounted to the housing for movement between a closed position, where the front cover overlies the filter basket and an inlet, and an open position, where the front cover is away from the filter basket and the inlet to permit the insertion and removal of a filter into and from the filter basket through the open top and the introduction of water through the inlet and into the reservoir through the conduit. The front cover of Diore '636 does not overlie the filter basket or an inlet, as called for in claim 31.

The combination of Marchant '640 and Diore '636 is logically and functionally impossible. Even if the combination were proper, the resulting device would not equal the invention of claim 6. The reservoir of Marchant '640 is located in the rear portion where the

basket of Diore '636 is located, and the basket of Marchant '640 is located in the front portion where the reservoir of Diore '636 is located. The combination of Marchant '640 and Diore '636 is illogical, since both configurations are equally operable and the combination would be inoperable. The combination of Marchant '640 and Diore '636 would result in a coffeemaker having front and rear baskets and front and rear reservoirs, or front and rear baskets with no reservoir, or front and rear reservoirs with no basket. None of these are the invention of claim 31. The rejection appears to be based on simply "cherry-picking" elements from different references and combining the elements in such a way as to approximate Applicant's invention, which is the essence of impermissible hind-sight reconstruction.

For the above reasons, claim 31 is patentable over Marchant '640 in view of Diore '636. Because claim 6 depends from claim 31, it is for the same reasons patentable over Marchant '640 in view of Diore '636. Applicant requests the withdrawal of the rejection, and the allowance of claims 6 and 31.

Claims 15-18 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Diore '636 in view of Beil '600. The rejection is traversed.

Initially, Beil '600 is not analogous art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 864, 26 USPQ2d 1767 (Fed. Cir. 1993). While Patent Office classification is some evidence of analogy, the similarities and differences in structure and function of the inventions disclosed in the references carry far greater weight. *In re Clay*, 966 F.2d 656, 23 U.S.P.Q.2D (BNA) 1058 (Fed. Cir. 1992).

The first requirement has not been met. Beil '600 is in a field which is entirely different from the field of Applicant's invention. Beil '600 is directed to a two-piece cover assembly

configured to hold ash from a cigar or cigarette which can be tilted to deposit the ash and spent cigar/cigarette in an underlying receptacle. This is entirely different from the field of art of Applicants' invention, which is directed toward coffeemakers.

Beil '600 is also not reasonably pertinent to the problem with which Applicant was concerned. The problem to be solved by the reference invention is the maintenance of an ash receptacle closure assembly in a closed position. The problem to be solved by Applicant's invention is the difficulty in accessing the water reservoir and coffee filter basket in a conventional coffeemaker.

Finally, the structure and function of the reference invention and Applicant's invention are significantly different. The reference invention comprises an ash receptacle having a two-piece cover assembly configured to hold ash from a cigar or cigarette which can be tilted to deposit the ash and spent cigar/cigarette in the receptacle, and which is maintained in a closed position by a pair of long, helical springs extending across the underside of the cover pieces. The function of the device is to maintain the closure assembly in a closed position to minimize the spillage of ash from the receptacle. In contrast, Applicant's invention is a coffeemaker having a coffee filter basket at a front of the coffeemaker, a reservoir at the rear, an inlet at the front for introducing water into the reservoir, and a cover assembly having a portion that can be opened and closed over the front to enable access to the filter basket and the inlet. The function of Applicant's invention is to provide access to the filter basket and inlet at the front of the coffeemaker through a cover that can be opened without moving the coffeemaker away from an overhanging fixture. A person of ordinary skill seeking to solve the problem of improving access to a coffeemaker filter basket and enabling the reservoir to be filled from the front of the coffeemaker would not consider a device whose purpose is to keep cigar and cigarette ash from spilling out of an ash receptacle. Thus, Beil '600 is nonanalogous art, the combination is improper as made, and the rejection based on the improper combination is not sustainable.

Furthermore, the combination as made in the Office action fails to identify any motivation, suggestion, or teaching in either Beil '600 or Diore '636 of the desirability of combining Beil '600 and Diore '636 to arrive at Applicant's invention. There has been no statement identified in either Beil '600 or Diore '636 as to the desirability of the asserted

combination, there has been no discussion of the knowledge of one of ordinary skill in the art or the nature of the problem to be solved, there has been no identification of what the teaching of Beil '600 and Diore '636, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to one of ordinary skill in the art as required for a showing of motivation. The combination as asserted fails to provide any particular findings related to any motivation, suggestion, or teaching of the desirability of combining Beil '600 and Diore '636. The combination as asserted simply relies upon "broad conclusory statements standing alone," which can only lead to the conclusion that the combination as asserted is simply based on impermissible hindsight reconstruction of Applicant's invention.

Finally, claims 15-18, in pertinent part, call for a coffeemaker having a housing, a water reservoir located in the rear portion of the housing, a filter basket located in the front portion of the housing, a rear cover moveably mounted to the housing overlying the water reservoir, a front cover moveably mounted to the housing overlying the filter basket, and a linkage connecting the front and rear covers. This does not result from the combination of Beil '600 and Diore '636.

As discussed above, the front cover of Diore '636 does not overlie the filter basket, as called for in claim 15. The water reservoir is not located in the rear portion of the housing, and the filter basket is not located in the front portion. These elements are not provided by Beil '600. There is no linkage connecting the covers in Diore '636. As discussed above, the cover portions in Beil '600 are not connected by a linkage. Even if the combination of Beil '600 and Diore '636 were proper, which it is not, the combination would fail to equal the invention of claim 15. The combination would equal a coffeemaker having a water reservoir located in the front portion of the housing, a filter basket located in the rear portion of the housing, a front cover overlying the reservoir but not the filter basket, and a pair of covers unconnected by a linkage. This is not the invention of claim 15.

For the above reasons, claim 15 is patentable over Diore '636 in view of Beil '600. Because claims 16-18 depend from claim 15, they are for the same reasons patentable over Diore '636 in view of Beil '600. Applicant requests the withdrawal of the rejection, and the allowance of claims 15-18.

### **CONCLUSION**

For the reasons discussed above, all claims remaining in the application are allowable over the prior art. Early notification of allowability is respectfully requested.

If there are any remaining issues which the Examiner believes may be resolved in an interview, the Examiner is respectfully invited to contact the undersigned.

Respectfully submitted,  
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